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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,831	01/15/2004	Roelof Van Ginkel	8500-0276.11	7137
23980	7590	02/02/2005	EXAMINER	
REED INTELLECTUAL PROPERTY LAW GROUP 800 MENLO AVENUE, SUITE 210 MENLO PARK, CA 94025			NYALLEY, LANSANA	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/758,831	Applicant(s) VAN GINKEL ET AL.	
	Examiner Lansana Nyalley	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-29 is/are pending in the application.

4a) Of the above claim(s) 19-29 is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1-18 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date ____.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. ____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: ____.

Application/Control Number: 10/758,831
Art Unit: 1621

Page 2

1. This application of number 10/758,831 is a division of application of number 10/346,297, filed on 01/15/2003, now a patent of number 6/720,442; which is a division of application of number 09/762,264, filed on 02/02/2001, now a patent of number 6/548,708, which is a 371 of PCT/EP 99/05758, filed on 08/03/1999; claims benefit of EP 98306254.8, filed on 08/05/1998 and EP 98203587.5 filed on 10/23/1998.
2. The information disclosure statement filed is acknowledged.
3. Claims 1-29 are pending.

DETAILED ACTION

Double Patenting

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection Based upon 35 U.S.C.

OBVIOUSNESS TYPE, NO SECONDARY REFERENCE

Claim Rejections - 35 USC § 101

Claims 6, 8, 9, 11- 17 of the instant application are rejected under 35 U.S.C. 101 as claiming the same invention as claims 1-3 and 5-9, U.S. Patent No. 6,720,442 B2. This is a double patenting rejection.

Art Unit: 1621

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Claims 1-4, 6, 7, 10, 17 and 18 of the instant application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5 and 9 of U.S. Patents Nos. 6,548,708 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the prior art of US patent 6,720,442 B2 ("442") and the instant application is that in "442", the symbol R, represents a hydrocarbyl, substituted aryl, an aryl substituted with a polar moiety or a substituted hydrocarbyl; the symbol E1, represents an optionally substituted alkyl group of C1-C12 and a temperature of at least 40 degrees Centigrade is employed. Whereas, in the instant application, the symbol R1 represents an aryl group, the symbol E1 represents a substituted alkyl group and a temperature of not more than 60 degrees Centigrade is employed.

These modifications of the instant claims over the prior art would have been obvious to one of ordinary skill in the art at the time the invention was made because based on the

Art Unit: 1621

above, "442" teaches the elements of the claimed invention with sufficient guidance, and with a reasonable expectation of success, that the invention would be prima facie obvious to one of ordinary skill, i.e. the prior art reference teaches or suggests all the claim limitations with a reasonable expectation of success. see M.P.E.P. 2143.

Additionally, one would have been motivated to have selected from an optionally substituted alkyl group from C1-C12 represented by E1 of the prior art for a substituted alkyl group represented by E1 of the instant application. Also, One will be motivated to substitute a temperature of not less than 40 degrees Centigrade that the prior art teaches for a temperature of 60 degrees Centigrade that the instant application recites in order to produce a phosphorus- containing compound useful in the preparation of a polymerization catalyst because 60 degrees Centigrade is above and still closer to the 40 degrees Centigrade that the prior art teaches.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 5 of the instant application, directed to a process of making a compound of formula R3P, is unaffected by the double patenting of the claims.

Art Unit: 1621

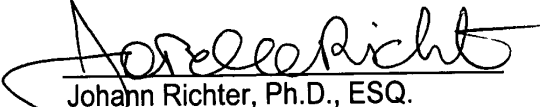
In a phone conversation with the attorney of record, Mr. Mark Warzel on 01/27/05 for election of a group from the restriction for prosecution on the merit, Group I, claims 1-18 was elected with traverse.

CONCLUSION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lansana Nyalley whose telephone number is 571,272,0697. The examiner can normally be reached on 7:45 to 4:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571 272 0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lansana Nyalley Ph.D.
01/19/05


Johann Richter, Ph.D., ESQ.
Supervisory Patent Examiner,
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Application/Control Number: 10/758,831

Page 6

Art Unit: 1621